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In re Application of
YAMASAKI et al.
Application No.: 09/647,772
PCT No.: PCT/JP99/01798
Int. Filing Date: 05 April 1999
Priority Date: 06 April 1998
Attorney Docket No.: 06501-065001
For: INDOLE DERIVATIVES

DECISION ON PETITION

This decision is in response to applicants' "Petition to Revive Application under 37 CFR 1.137(b)" filed 06 November 2002. In response to the 06 September 2002 "Decision" mailed by this Office, applicant filed the present petition under 37 CFR 1.137(b).

BACKGROUND

On 05 April 1999, applicants filed international application PCT/JP99/01798, which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 October 1999. On 20 October 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 06 October 2000.

On 04 October 2000, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and a copy of the international application.

On 06 November 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e).

On 04 April 2001, applicants filed the surcharge under 37 CFR 1.492(e) and a declaration and power of attorney executed by Noritsugu Yamasaki; Takafumi Imoto; Hiroshi Kayakiri; Osamu Onomura; Takahiro Hiramura as inventors and Noriko Oku, Chikado Oku, and Tomohito Oku on behalf of deceased inventor, Teruo Oku. In a decision dated 27 July 2001, applicants request under 37 CFR 1.42 was refused.

On 11 February 2002, applicants filed "Renewed Submission under 37 CFR 1.42" which was refused in a decision dated 02 April 2002.

On 10 June 2002, applicants filed (second) "Renewed Submission under 37 CFR 1.42." In a decision dated 06 September 2002, applicants' renewed petition was dismissed and the application was abandoned.

On 06 November 2002, applicants filed the present petition.

DISCUSSION

A. Petition under 37 CFR 1.42

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

A review of the declaration filed 06 November 2002 reveals that Noriko Oku, Chikado Oku, and Tomohito Oku have executed the declaration as "representatives" of Teruo Oku. Additionally, Noriko Oku, Chikado Oku, and Tomohito Oku assert that they are "all of the heirs" of the deceased inventor. Therefore, the declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b).

The submission of the declaration executed by all of the heirs of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

B. Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the declaration filed on 06 November 2002.

As to Item (2), the appropriate petition fee of \$1280.00 as required by 37 CFR 1.17(m) was submitted.

With regard to Item (3), applicants' statement that "entire delay in filing the 35 U.S.C. 371(c) requirement from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 06 November 2002.

CONCLUSION

The request under 37 CFR 1.42 is ACCEPTED.

The petition under 37 CFR 1.137(b) is GRANTED.

The application will be given an international filing date of 04 April 1999 under 35 U.S.C. 363, and a date of **06 November 2002** under 35 U.S.C. 371(c).

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.



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